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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/772,244	01/29/2001	Rajkishore Barik	JP920000376US1	9198
7590 06/05/2006			EXAMINER	
McGinn & Gibb PLLC Suite 304 2568 A Riva Road Annapolis, MD 21401			CARLSON, JEFFREY D	
			ART UNIT	PAPER NUMBER
			3622	

DATE MAILED: 06/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/772,244	<b>Applicant(s)</b> BARIK ET AL.	
	<b>Examiner</b> Jeffrey D. Carlson	<b>Art Unit</b> 3622	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 March 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-5,7-12,14-19,21-31,33-44,46-57,59-62 and 64-66 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5,7-12,14-19,21-31,33-44,46-57,59-62 and 64-66 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

This action is responsive to the paper(s) filed 3/17/06.

#### ***Specification***

1. The disclosure is objected to because of the following informalities:
  - Applicant's Brief Description of the Figures does not specify figures 11a and 11b. Applicant's amendment to the specification does not appear to remedy the problem.

Appropriate correction is required.

#### ***Claim Objections***

2. Claims 12, 48, 65, 66 are objected to because of the following informalities:
  - Claims 12, 48, 66 are objected to as not further limiting the parent claims. The base claims set forth particular features (structure configured for determining, checking, displaying), yet claims 12, 48, 66 do not further define the structure of the apparatus/system, but merely describe qualities of the coupons acted upon by the system.
  - Claim 65 does not further limit the structure of the system/apparatus, but rather states where such system/apparatus is located. The location of an article does not serve to define the article.

Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-66 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- Claims 1, 8, 15, 22, 36, 49, 62 are of unclear claim scope because the phrase “coupons...not being mutually exclusive” does not state what qualities in particular of the coupons are not mutually exclusive.

- Claim 34, there is no antecedent basis for said profile.

Appropriate correction is required.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. **Claims 1-5, 7-12, 14-19, 21-31, 33, 35-44, 46, 48-57, 59, 61-62, 65, 66 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fajkowski (US6932270).**

Regarding claims 1, 2, 8, 9, 15, 16, 27, 30, 41, 44, 54, 57, Fajkowski teaches systems and methods for storing electronic coupons, associating them with customers,

presenting them at a retail POS and redeeming them. A user is provided with a card which provides a userID [4:6-8]. The card is used to associate selected coupons from a plurality of available coupons from different sources (by scanning paper coupons, by selecting coupons at a kiosk or by downloading coupons from the Internet) with the user's account in a database [3:63-65, 6:1-5, 6:22-25]. When the card is presented at the POS along with products to be purchased, the POS system determines what coupons of the user's collection of selected coupons are redeemable given the user's potential purchases; the system displays these coupons on the display [16:18-31, 17:31-33, 4:25-35]. Fajkowski teaches that the coupon eligibility parameters (product name, required size, quantity or combination of items required, expiration) may be stored on the card in order to determine applicable coupons at the POS [10:17-26]. Applicant admits that mutual exclusivity is a restrictive, eligibility coupon parameter often used [spec page 1 lines 21-22]. It would have been obvious for one of ordinary skill in the art at the time of the invention to have stored and analyzed other well known coupon restriction rules such as whether other coupons can be used in combination with a coupon. Doing so would enable the system to process and accurately display a wide variety of coupons, including those with exclusivity rules. Regarding the display of selected coupons based upon optimization parameters, the display of eligible coupons to be redeemed at the POS is taken to provide such a feature; if the customer has the proper products at checkout, the displayed coupons represent optimized savings. Further still, the act of displaying eligible coupons plus "near-eligible" coupons (as discussed below with regards to claims 4, 11, 18) demonstrates further optimization.

Regarding claim 3, 10, 17, Fajkowski teaches that all useable coupons are displayed and that the user may choose which ones to redeem and which ones to save for later [21:22-25]. The act of displaying all eligible coupons is taken to provide a suggestion of an optimal/near-optimal set of coupons to redeem, however the user is free to select only some of the displayed coupons.

Regarding claims 4, 11, 18, Fajkowski teaches that coupons could be displayed which are not fully eligible along with the reasoning for their near-eligible status, such as the product is the wrong size [19:38-43]. It would have been obvious for one of ordinary skill in the art at the time of the invention to have displayed a similar message when a user has not presented the proper quantity or combination of products [these parameters are disclosed at 10:22-23] when possessing a coupon with such size or quantity restrictions. Both of these examples are taken to provide a teaching of recommending the missing product to the customer for more discounts.

Regarding claims 5, 12, 19, 35, 48, 61, 65, 66, Fajkowski teaches that the coupons may at least be stored at a third party site (Internet) or kiosk (retailer site). The system is taken to reside at the retailer site.

Regarding claims 7, 14, 21, the network is described as the Internet.

Regarding claims 22, 23, 36, 37, 49, 50, 62, Fajkowski's determination of coupons specific to products presented is taken to provide a step of computing a set of coupons dependant upon a user's set of coupons as well as upon the order information. The step of determining if the computed coupon set complies with redeeming conditions is met by inspecting the other various criteria such as expiration, etc.

Regarding claim 24, 38, 51, if in Fajkowski a customer provides a coupon that does not comply with redemption criteria, the customer is free to return another time with a another set of coupons.

Regarding claims 25, 26, 39, 40, 52, 53, Fajkowski teaches that while compliant coupons are shown at the POS, the customer may wish to investigate why some coupons were non-complaint [19:21-25]. The POS may be used to display all coupons that were non-compliant [19:44-53]; it would have been obvious for one of ordinary skill in the art at the time of the invention to have displayed non-compliant coupons for any non-compliant criteria including the suggested mutually exclusive criteria above.

Regarding claims 28, 29, 42, 43, 55, 56, Fajkowski teaches that the user may save shopping lists with specified coupons for the products on the list to be used on future shopping trips. Fajkowski also teaches the idea of issuing a rain check for a coupon item the user wishes to purchase, but where the item is currently unavailable. The system will save such a list of rain-checked product(s) for later use. In either case, future use of the saved lists are taken to meet the broad "comparing" by a user.

Regarding claim 31, Fajkowski teaches that a user may be provided with reports of coupon usage and savings [13:5-7, 17:48-63]. User acceptance for redemption of the displayed eligible coupons provides a viewing of reports of coupon usage.

Regarding claim 33, 46, 59, the system is taken to inherently use an AND condition for a coupon having plural redemption conditions (expiration date and product size, for example).



**Claims 3, 10, 17 (alternatively) and 34, 47, 60, 64 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fajkowski in view of Beach et al (US2002/0107738).**

Beach et al also teaches user collection of e-coupons which are redeemed at the POS [para. 13]. Beach et al teaches that coupons can be recommended to the user based on his user profile [para. 35 (middle of page)]. It would have been obvious for one of ordinary skill in the art at the time of the invention to have suggested coupons for the user based on his profile so that the user can be conveniently targeted with offers that are likely to be accepted and purchased. These recommendations are taken to be optimal or near optimal recommendations.

### ***Response to Arguments***

Applicant argues that the Office Action does not reference any support in the prior art for its contention that incorporating mutual exclusivity would have been obvious. The Office Action now notes that the concept of coupon exclusivity has been admitted by applicant to be prior art [spec pg 1 lines 21-22]. Examiner believes that Fajkowski's teaching for analyzing various coupon eligibility parameters in order to determine applicable coupons at the POS would motivate one of ordinary skill to analyze other known eligibility parameters such as mutual exclusivity.

Applicant's arguments appear to be based upon the details of disclosed optimization rather than the presently broad claim optimization language. Applicant argues that Fajkowski would display mutually exclusive as well as non-mutually



exclusive coupons. Perhaps so, but applicant's claims are devoid of any requirement NOT to display any mutually exclusive ones, although it would have been obvious to have displayed eligible coupons given exclusivity rules as argued by examiner. Further, a customer is free to approach the POS of Fajkowski with nothing but non-mutually exclusive coupons in his possession or free to approach the POS with a particular set of coupons in his possession that can be redeemed in their entirety and be considered fully optimized (i.e. in the case where the instant invention would do nothing to the set of eligible coupons – perhaps if the customer only had one coupon or had such a small amount of coupons that there were no “conflicts” to resolve). There are no particular steps specified in the claims that accomplish the optimization. Applicant argues that Fajkowski lacks optimization based upon discount, free items or expiration, yet these specific examples are not required by the claims.

Applicant argues that the display of eligible coupons is not described by Fajkowski as providing coupon optimization. Fajkowski need not say so – the teachings considered to be obvious to one of ordinary skill based upon Fajkowski are interpreted by the Examiner as meeting the *broadly* claimed optimization. In most scenarios, the more coupons you use, the more your savings. Scenarios that differ from this generality are not required to be present or analyzed by the proposed system based upon applicant's currently broad claim language. As long as the claim language is met by a single scenario, the claim language is met. Further, the act of displaying eligible coupons plus “near-eligible” coupons (with regard to the rejection for claims 4, 11, 18) demonstrates further optimization. Similarly, applicant's specification describes the

benefits of optimization where huge coupon discounts are achievable if only the customer is notified of the condition to purchase "one more product" [spec pg 3 lines 18-23].

Applicant appears to argue that some coupons of the instant invention are not displayed merely because they are eligible. No such limitations are presently in the claims.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey D. Carlson whose telephone number is 571-272-

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6716. The examiner can normally be reached on Mon-Fri 8a-5:30p, (off on alternate Fridays).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571)272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Jeffrey D. Carlson  
Primary Examiner  
Art Unit 3622

jdc